

REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated June 2, 2006. Reconsideration and allowance is requested.

Claims 13, 15-23 remain in this application. Claims 1-12, 14, 24-58, 62, 66, and 68-72 were previously canceled. Claim 59-61, 63-65 and 67 were previously withdrawn.

Claim Rejection under 35 USC 103

In the Office Action, the Examiner rejected claims 13, 15-17, and 21-23 under 35 USC 103(a), as being unpatentable over Higgins III (U.S. Patent 5,639,989) in view of Nagaike et al. (U.S. Patent 5,945,213). In the previous office action, the Examiner rejected these claims using the same argument presented in this office action. In response, the Applicant argued that the Examiner did not establish a prima facie case for obviousness because the Examiner did not satisfy all three criteria for obviousness outlined in MPEP 2143. However, the Examiner was not persuaded. In this office action the Examiner rejected the claims using the same reasoning and argued:

Applicants argument on the motivation between the references of Higgins III and Nagaike et al. mentioning the Nagaike et al. states "it is not easy to form EMI shields over plastic jacket", but actually the Higgins III teaches "a molded plastic housing maybe coated with thin metal film (col. 2, lines 50-51)". So the combination is possible.

The Applicant respectfully traverses. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01 and In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here the Examiner appears to be arguing that just because the combination is possible then there is motivation to combine the references. The Applicant respectfully submits that this line of reasoning is impermissible. Moreover, the Applicant would like to stress, again, that Nagaike clearly states in column 2 lines 32-33 that "it is not easy to

form EMI shields over surfaces of plastic jackets." The Applicant believes that if one skilled in the art had read Nagaike, that person would not have been motivated to deposit metallized layers onto plastics but rather would have been persuaded to not deposit metallized layers onto plastics. The Applicant would also like to point out that Nagaike appears to teach against modifying Higgins III to include a vacuum metallized layer because Nagaike's entire disclosure appear to discuss the problems with depositing metal layers onto plastics and encourages using a paint composition applied to the plastic to form an undercoat before the metal layer is electropolished onto it. The Applicant believes that the arguments made in the previous response to office action regarding motivation to combine are still relevant and respectfully request that the Examiner reconsider his rejection based on these remarks and the remarks made in the previous response to office action.

In the Office Action, the Examiner rejected claim 15 under 35 USC 103(a), as being unpatentable over Higgins III/Nagaike et al. as applied to claim 13 above, and further in view of Chant (U.S. Patent 4,797,508). The Examiner argued that Chant teaches the step of maintaining a temperature of the electronic component and insulating base coating below approximately 200 degree C during vacuum metallizing (col. 9 lines 1-9) and that one skilled in the art would have combined Chant with Higgins III/Nagaike so as to achieve the vacuum metallized deposit embedded substantially in the coating. The Applicant respectfully disagrees. In column 9 lines 1-9 Chant teaches:

The process as set forth in Example One is substantially repeated except that the coating has a thickness of about 1.5-2.0.times.10.sup.-3 inch, and the final curing step is effected after the formation of the vacuum metallized deposit by subjecting the partially processed board to a temperature of 280.degree. F. for 3 hours at 250 p.s.i. After the application of the heat and pressure in this step, the vacuum metallized deposit appears to be substantially embedded in the coating.

Clearly Chant fails to teach claim 15 because claim 15 recites maintaining a temperature of the electronic component and insulating base coating below approximately 200°C during vacuum metallizing. Chant teaches a process performed at 250 p.s.i, which is a high

pressure process, and not a vacuum process. Vacuum processes are performed at pressures below atmospheric pressure, which is 14.7 psi, and Chant teaches a process which is at 250 psi. Chant's curing process is performed at a very high pressure and not under vacuum metallization conditions. These processes are completely different and the temperature range mentioned of the curing process has nothing to do with a temperature range of the vacuum metallization deposition process. Therefore, the Applicant respectfully requests that the Examiner reconsider his rejection of claim 15 for this reason. Additionally, claim 15 is patentable because it depends from claim 13 which is patentably distinct over the prior art for the reasons given above.

In the Office Action, the Examiner rejected claims 18 and 19 under 35 USC 103(a), as being unpatentable over Higgins III/Nagaike et al. as applied to claim 13 above, and further in view of Askew (U.S. Patent 5,350,951). First, since claims 18 and 19 depend from claim 13, which is patentably distinct over the prior art for the reasons given above, claims 18 and 19 are also patentable. Second Askew fails to teach applying an insulating conformal layer over the first conductive layer as recited in claim 18 and that the conformal layer is waterproof as recited in claim 19. Askew only teaches that there is a second layer. Askew second layer cannot be conformal because it only covers a portion of the first layer. Moreover, there is nothing to suggest that Askew's second layer is insulating or waterproof, as claimed. Therefore, the Applicant submits that claims 18 and 19 are patentably distinct over the cited prior art.

In the Office Action, the Examiner rejected claim 20 under 35 USC 103(a), as being unpatentable over Higgins III/Nagaike et al. as applied to claim 13 above, and further in view of Gabower. Since claim 20 depends from claim 13, and claim 13 is patentably distinct over the prior art for the reasons given above, claim 20 is also patentable.

CONCLUSION

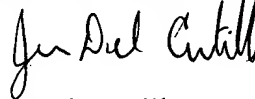
In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/788,263
Amdt. dated November 2, 2006
Reply to Office Action of June 2, 2006

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Jesus Del Castillo
Reg. No. 51,604

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
JDC:gjs
60802327 v1